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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,139	02/20/2004	D. Peter Beirne JR.	3759600-144128	5359
23570	7590	01/22/2007	EXAMINER	
PORTER WRIGHT MORRIS & ARTHUR, LLP			KENNEDY, JOSHUA T	
INTELLECTUAL PROPERTY GROUP			ART UNIT	PAPER NUMBER
41 SOUTH HIGH STREET			3679	
28TH FLOOR				
COLUMBUS, OH 43215				
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE		DELIVERY MODE	
3 MONTHS	01/22/2007		PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/784,139	BEIRNE ET AL.	
	Examiner	Art Unit	JK
	Joshua T. Kennedy	3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 November 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3-8 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3-8 and 11-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

Claims 1, 3-8, and 11-20 have been examined.

Claims 2, 9, and 10 have been cancelled.

### *Specification*

The title of the invention is misdescriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. It is suggested that Applicant remove "and floor" from the title since all that is now being claimed is a protection device for roof openings.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-8, and 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pena (US Patent 5,820,497) in view of Willetts (US Patent 4,600,179) and Perkins (US Patent 6,688,046).

As to Claims 1, 3, 7, 11-13, 17, 19, and 20. Pena discloses a fall protection device comprising:

at least one rail section having a plurality of vertical members (4) each having a lower end (9);

a plurality of horizontal members (13) connecting the vertical members;

a plurality of bearing feet (Figs 1 & 2) each having a connecting portion (5) and a bearing portion (6);

wherein each bearing foot is secured to the lower end of one of said plurality of vertical members (Claim 1, Lines 3-6);

wherein the connecting portion (5) of the bearing foot is frusto-conical shaped;

wherein the frusto-conical shaped connecting portion engages the vertical member

wherein a first material forming the bearing portion having a first material hardness greater than a second material hardness of a second material forming the connecting portion (Col 3, Lines 33-39); and

However Pena does not disclose a roof having an opening therein and the fall protection device being about at least a portion of the opening.

Perkins teaches a safety rail system (Fig 1) to be assembled on a roof (10) about an opening (11) "to provide the hatch with a guard rail firmly bolted or similarly rigidly secured to the roof surface" (Col 1, Lines 16-18). The use of such a safety rail system on a roof hatch or skylight would have been obvious to one of ordinary skill in the art because rail system about hatches and similar roof openings are often used on rooftops to prevent persons from falling into the aforementioned openings and Perkins is evidence of such.

Pena does not disclose a bearing portion being disc shaped and being co-molded of polypropylene having a circular outer periphery having a lower edge being rounded, an upper surface, and a lower surface parallel with the upper surface and spaced from the upper surface; wherein the lower surface of the bearing portion being capable of resting on a roof and the lower end of the vertical member engages the upper surface of the bearing portion being capable of supporting the vertical member above the roof so that the vertical members do not engage the roof; and the connection portion being resiliently deformed to secure the bearing foot to the vertical member with an interference fit and resist removal of the bearing foot from the vertical member.

Willetts teaches a post to rail connection having a bearing portion being disc shaped (52) and being co-molded of polypropylene (Col 3, Line 14) having a circular outer periphery having a lower edge being rounded (Fig 9), an upper surface, and a lower surface parallel with the upper surface and spaced from the upper surface (Figs 5 and 6); wherein the lower surface of the bearing portion being capable of resting on the roof and the lower end of a vertical member is capable of engaging the upper surface of the bearing portion being capable of supporting the vertical member above the roof so that the vertical members do not engage the roof and a connection portion being resiliently deformed to secure the bearing foot to the vertical member with an interference fit and resist removal of the bearing foot from the vertical member and "to better seal against the entrance of moisture" (Col 3, Lines 23-24). It would have been obvious to one of ordinary skill in the art to modify the bearing foot of Pena to have a resilient connecting portion and a disc shaped bearing portion as taught by Willets "to

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tightly hold the rung and seal its aperture to block any entrance of water inside the rail" (Col 3, Lines 20-31).

Pena also does not disclose the tube being metal. However, does state "that numerous materials can be used" (Col 3, Lines 33-34) for the construction of the posts and rails and it is noted that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). It would have been obvious to one of ordinary skill in the art to modify the vertical posts of Pena to be metal to provide a sturdier frame.

As to Claim 4 and 14. Pena discloses each of the plurality of vertical members as in the form of a tube (Col 2, Line 67).

As to Claims 5 and 15. Pena discloses each bearing foot having an axially extending passage formed therein which extends through both the bearing portion and the connecting portion and communicates an interior space of a tube with ambient space outside the tube so that any liquid that enters the tube flows out of the bottom of the tube through the passage in the bearing foot by gravity (Figs 1 & 2).

As to Claims 6 and 16. Pena discloses the connecting portion of the bearing foot extends into an open lower end of the tube (Figs 1 & 2) and resiliently engages an

interior surface of the tube to secure the bearing foot thereto (Col 2, Lines 64-67; Col 3, Lines 1-11).

As to Claims 8 and 18. Pena in view of Willetts disclose the bearing portion having an upper surface and a lower surface spaced from the upper surface, but does not disclose the thickness of the bearing portion being at least 0.25 inches.

It is not inventive to state the optimum values of a thickness of the bearing portion. Although silent on the dimension, the device of Pena in view of Willetts inherently has a thickness relative to the size of the leg support. Through routine experimentation and optimization, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the leg support of Pena in view of Willetts to have the thickness of the bearing portion being at least 0.25 inches producing no new and unexpected results.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 3-8, and 11-20 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment, specifically the addition of the limitation of "a roof having an opening therein" (Claim 1, Line 3), necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See

MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua T. Kennedy whose telephone number is (571) 272-8297. The examiner can normally be reached on M-F: 7am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JTK  
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1/5/2007



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